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EXAMINER

MCALLENAN, J

ART UNIT

PAPER NUMBER

3745

DATE MAILED: 09/26/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/397,134

Applicant(s)  
Thien

Examiner  
James M. McAleenan

Group Art Unit  
3745



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-12 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-12 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Sep 16, 1999 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 2 objected to because of the following informalities: Claim 2 should be written so as to clearly define the claimed invention, examiner suggests to delete "are so designed that, despite the alternating changes of volume of the individual bodies (12)," and insert --, such that each of the individual bodies have changing relative volumes, wherein--.

The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claim 1, the phrase "in such a way" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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Regarding claim 6, the phrase "can be taken off" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 7, the phrase "preferably all" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 12, the phrase "preferably via" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 8 recites the limitation "the piston" in line 3. There is insufficient antecedent basis for this limitation in the claim. Examiner suggests to overcome the objection by rewriting claim 8, replacing "the" by inserting --having a--.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The claimed invention is inoperative because even though the Applicant has mentioned friction in the specification (see page 2, lines 15-16; page 4, lines 1-

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3; and page 9, lines 1-5.), Applicant has inherent frictional problems with the claimed invention. Note, Applicant has not mentioned the impact of hitting the surface of the liquid with the piston-and-cylinder unit (12) at the lower deflection device (30) point when entering the liquid. Note, Applicant has not mentioned the sliding friction of the piston-and-cylinder unit (12) between the cylinder (20) and the cylinder chamber (16). Although Applicant has mentioned the mechanical action (see page 5, lines 32-39) of the piston-and-cylinder unit (12) between the cylinder (20) and the cylinder chamber (16), Applicant has not considered the potential frictional effect. Applicant has not mentioned the frictional effect of the piston-and-cylinder unit (12) between the cylinder (20) and the cylinder chamber (16) when positioned at the top of the device at point 12.1a as shown in Figure 3. Applicant has not disclosed that the claimed invention will run for any particular period of time, thus leaving the examiner to assume this may be considered as a perpetual motion apparatus. If the claimed invention is a perpetual motion apparatus, Applicant has failed to mention any exterior power used to start the claimed invention. Note further, that the Applicant has failed to mention to what purpose the supposed created energy will be used. Note, Applicant has mentioned the created energy from the claimed invention may be used for supplying torque to a generator, but for what purpose?

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 10-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Diamond (U.S. Patent Number 3,934,964) or Kusmer (U.S. Patent Number 3,412,482) or Great Britain Patent Number 35,705. Diamond, Kusmer and Great Britain Patent Number 35,705 disclose an apparatus for generating torque, along with having at least two bodies coupled to one another that perform a rotational movement, in which one body moves in the direction of the force of gravity and the other in the direction opposite thereto. See Figures 1-11 of Diamond; Figures 1-5 of Kusmer; and Figures 1-5 as well as the unlabeled Figure of Great Britain Patent Number 35,705.) Note Diamond, Kusmer and Great Britain Patent Number 35,705 teach each body, when changing the direction of movement, alters its volume so that the volume of the body or bodies move in the direction of the force of gravity that is less than that of the bodies moving in the opposite direction. Regarding claim 2, Diamond, Kusmer and Great Britain Patent Number 35,705 disclose the two bodies coupled to one another in that the two bodies, despite the alternating changes of volume of the individual bodies, the total volume of the all the bodies is substantially constant. Regarding claim 3, Diamond, Kusmer and Great Britain Patent Number 35,705 teach the bodies are arranged opposite one another in pairs relative to the rotational movement. Regarding claim 4, Diamond, Kusmer and Great Britain Patent Number 35,705 disclose the bodies become immersed in a liquid during at least part of their rotational movement. Regarding claim 5, Diamond, Kusmer and Great Britain Patent Number 35,705 teach the

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individual bodies are connected to one another by a tension member which runs in an annular manner over at least one deflection device. Regarding claim 6, Diamond, Kusmer and Great Britain Patent Number 35,705 disclose the deflection apparatus possesses at least one deflection wheel which is mounted on a shaft from which the torque can be taken off. Regarding claim 7, Diamond, Kusmer and Great Britain Patent Number 35,705 teach that each set of two bodies are assigned to one another as a pair, preferably all bodies have the same dimensions. Regarding claim 8, Diamond, Kusmer and Great Britain Patent Number 35,705 disclose each body designed as a piston-and-cylinder unit, the piston being movable into its extended or retracted position by the weight acting on it as a function of the orientation of the piston-and-cylinder unit relative to the force of gravity. Regarding claim 10, Diamond, Kusmer and Great Britain Patent Number 35,705 teach each piston-and-cylinder, in the event of a change in direction of movement, is automatically transferred from its one position, in which the piston is extended or retracted, into its other position, in which the piston is, respectively, retracted or extended. Regarding claim 11, Diamond, Kusmer and Great Britain Patent Number 35,705 disclose the cylinder chambers of the individual piston-and-cylinder units are connected to one another in order to permit a fluid exchange. Regarding claim 12, Diamond, Kusmer and Great Britain Patent Number 35,705 teach the cylinder chambers are connected to one another in an annular manner, such as a hose.

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***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Diamond, Kusmer and Great Britain Patent Number 35,705. Diamond, Kusmer and Great Britain Patent Number 35,705 devices in the rejection of claim 1 above, discloses all of the claimed elements except that the Diamond, Kusmer and Great Britain Patent Number 35,705 devices do not disclose the specific shape or dimensions of the piston length as satisfying the equation:

Equation number 1: 
$$L_k \geq h * P_f / P_k$$

wherein h is the maximum depth of the immersion of the body in to the liquid,  $P_f$  is the density of the liquid and  $P_k$  is the density of the piston of the material.

Since applicant has not disclosed that having the piston length as satisfying the equation number 1 above, at these specific shapes and dimensions solves any stated problem or is for any particular purpose and it appears that the piston lengths of Diamond, Kusmer and Great Britain Patent Number 35,705 would inherently equate to equation number 1 as claimed by applicant, it would have been an obvious matter of design choice to modify the piston length of the Diamond, Kusmer and Great Britain Patent Number 35,705 devices by utilizing the specific shape and dimensions for equation number 1 as claimed.



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### CONTACT INFORMATION


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner James M. McAleenan whose telephone number is (703) 308-2827. The examiner can normally be reached on Monday - Friday from 9:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Look, can be reached on (703) 308-1044. The fax phone number for this Group is (703) 305-3588.

An inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

 2/15/00

James M. McAleenan  
Patent Examiner  
Art Unit 3745

  
**EDWARD K. LOOK**  
**SUPERVISORY PATENT EXAMINER**  
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2/15/00